

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1-3, 8 and 15-26 are pending. Non-elected claims were withdrawn from consideration by the Examiner, and are canceled without prejudice or disclaimer in response to his requirement. Amendments moot the objection to claims 8 and 14-15.

35 U.S.C. 112 – Definiteness

Claims 1-4, 8 and 13-15 were rejected under Section 112, second paragraph, as being allegedly “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Applicants traverse.

The Examiner alleged in the Action that the gene that is the object of Applicants’ invention should not be named by its GenBank accession no. Y11414. Therefore, in accordance with his requirement, the gene is named *Oryza sativa Myb* or OsMyb (see page 3, lines 12-13, of the specification) in the claims as amended.

The phrases “variable region” and “biological” are deleted from claims 4 and 8, respectively, because these limitations are not required for patentability.

Cancellation of claims 13-14 moots certain rejections.

In accordance with what appears to have been the Examiner’s suggestion, claim 15 is amended to recited “introducing and expressing” the gene in a transgenic plant.

Applicants request withdrawal of the Section 112, second paragraph, rejection because the pending claims are clear and definite.

35 U.S.C. 112 – Enablement

Claims 1-4, 8 and 13-15 were rejected under Section 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants traverse.

The Examiner admits that the specification is “enabling for a method of producing a stress tolerant transgenic plant comprising transformation of said plant with a Y11414 gene encoding SEQ ID NO:2” at page 5 of the Action. The present claims are limited to the gene encoding SEQ ID NO:2, but sequence identifiers are not used in the claims because no Sequence Listing was part of Applicants’ originally-filed disclosure and

inserting “SEQ ID NO:2” into the claims would be new matter. Therefore, the gene is named OsMyb (GenBank accession no. Y11414) in the pending claims. Applicants submit that amendment of the claims moots this rejection because the pending claims are consistent with the Examiner’s admission of enablement.

Withdrawal of the enablement rejection is requested.

35 U.S.C. 112 – Written Description

Claims 1-4, 8 and 13-15 were rejected under Section 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants traverse because the specification clearly provides adequate support for the OsMyb gene (GenBank accession no. Y11414).

Withdrawal of the written description rejection is requested.

35 U.S.C. 102 – Novelty

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). But inherency may not be established by probabilities or possibilities. *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) *quoting In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981) (“The mere fact that a certain thing may result from a given set of circumstances is not sufficient”). The extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) *quoting Continental Can id.* at 1749.

Claims 1-4, 8, 13 and 15 were rejected under Section 102(b) as allegedly anticipated by Osnanto et al. taken with the evidence of Pandolfi et al. and Solinas et al. Applicants traverse.

Osnanto discloses a method of improving cold tolerance in plants by using the OsMyb4 gene. It does not teach or suggest that tolerance to biotic and other abiotic stress would be similarly improved. There is also no evidence or reasoning presented in

the Action to support the assertion therein that tolerance to other types of stress would also be improved in Osnanto's plants. Therefore no case of inherency has been established. On the contrary, Pandolfi expressly discloses that treatments different from cold do not lead to the expression of the OsMyb4 gene (last paragraph before the Acknowledgements, "The other treatments" – i.e., anoxia, salt, dehydration, heat – "had no effect on OsMyb4 expression"). Therefore no correlation existed between other types of stress (e.g., anoxia, salt, dehydration, heat) and expression of the OsMyb4 gene.

Claims 1-4, 8 and 14-15 were rejected under Section 102(b) as allegedly anticipated by Alexandrov et al. Applicants traverse because Alexandrov fails to teach or suggest the OsMyb4 gene. Therefore, it cannot anticipate the pending claims using that gene.

Claims 1-4, 8 and 15 were rejected under Section 102(e) as allegedly anticipated by Cahoon et al. Applicants traverse because Cahoon fails to teach or suggest the OsMyb4 gene. Therefore, it cannot anticipate the pending claims using that gene.

Withdrawal of the Section 102 rejections is requested because all limitations of the claimed invention are not disclosed by the cited documents.

Conclusion

Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Gary R. Tanigawa
Reg. No. 43,180

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100